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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,596	01/30/2001	Mark R. Bennett	END9-2000-0188US1	2376
23550	7590	06/15/2004	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			THOMPSON JR, FOREST	
3 E-COMM SQUARE			ART UNIT	
ALBANY, NY 12207			PAPER NUMBER	

3625

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/772,596

Applicant(s)

BENNETT ET AL.

Examiner

Forest Thompson Jr.

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WJ

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-12,14,16-23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14,16-23 and 25-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This Office Action is responsive to applicant's amendment A filed 04/01/2004 (see Paper #8). Applicant's amendment A canceled claims 3, 13, 15, and 24, amended claims 1, 2, 4-7, 10-12, 14, 16, 18-22, and 25-30, and added new claim 31. Claims 1-2, 4-12, 14, 16-23, and 25-31 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (see Paper #7), or will be included here for clarity, as necessary. The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.
3. Claims 1-2, 4-12, 14, 16-23, and 25-31 have been examined.

***Claim Rejections - 35 USC § 102***

4. Claims 1-6, 9-15, 18-20, and 23-28 were rejected under 35 U.S.C. 102(b) as being anticipated by Barnes et al. Applicant's amendment necessitated revising the rejection, to include eliminating the Barnes et al. reference. Therefore, examiner withdraws the rejection.

***Claim Rejections - 35 USC § 103***

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5. Claims 7-8, 16-17, 21-22, and 29-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes et al. (U.S. Patent no. 5,970,475), and further in view of Burks et al. (U.S. Patent No. 5,644,778). Applicants' amendment and argument necessitated a change in the rejection. Therefore, examiner withdraws the rejection.

6. Claims 1-2, 4-12, 14, 16-23, and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al. (U.S. Patent No. 5,644,778).

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 18, 26: Burks et al. teaches:

- a processor (col. 8 lines 25-26);
- a computer system memory (col. 4 lines 8-17);
- an interface (col. 5 lines 15-19); and

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- a software product stored on the computer system memory and executable by the processor (col. 8 lines 10-24), wherein the software product comprises:
  - a translation system for translation a transaction element received from a first trading partner from a proprietary schema of the first trading partner into a universal schema and from the universal schema into a proprietary schema of a second trading partner; wherein translation of the transaction element comprises translating a data format and an application format of the transaction element (col. 3 lines 2-25);
  - a routing system for routing the transaction element from the first trading partner to the second trading partner in a communication protocol of the second trading partner (col. 3 lines 2-25); and
  - a transaction management system for managing tracking a status of the transaction element (col. 4 lines 8-17).

Claims 2, 23: Burks et al. teaches a mapping system for mapping the transaction element, wherein the mapping system includes a system for determining: a source of the transaction element, an application to which the transaction element is regarding, and a recipient to which the transaction element should be routed (col. 3 lines 2-25).

Claim 3. (Canceled)

Claims 4, 25, 31: Burks et al. teaches:

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- a data management system for providing localized data to the trading partners (col. 3 lines 2-25);
- a security system for controlling access to the automotive information exchange system (col. 9 lines 13-25);
- an administrative system for managing the automotive information exchange system (col. 3 lines 2-25); and
- a partner directory system for managing a partner directory of trading partners, wherein the partner directory identifies trading partners and their corresponding locations, transaction element schemas, communication protocols (col. 5 lines 42-65).

Claims 5, 19, 27: Burks et al. teaches the first trading partner comprises a mechanism for sending the transaction element to the automotive information exchange system (col. 5 lines 42-48).

Claims 6, 20, 28: Burks et al. teaches the second trading partner comprises a mechanism for sending a response transaction element to the automotive information exchange system, and the routing system routes the response element to the first trading partner in a protocol of the first trading partner (col. 6 line 63 – col. 7 line 24).

Claims 7, 16, 29: Burks et al. teaches the first and second trading partners are selected from the group consisting of an automotive manufacturer, an [a] automotive parts locator, an automotive parts supplier, an automotive lending provider, a credit

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reporter, a motor vehicle department, an automotive insurance provider, and an automotive consumer facilitator (col. 3 lines 2-37).

Claims 8, 17, 22, 30: Burks et al. teaches the transaction element and the response transaction element pertain to an automotive application selected from the group consisting of automotive parts, automotive sales, automotive service, automotive insurance, automotive registration, automotive financing, automotive warranty, and credit reporting (col. 7 lines 10-24).

Claim 9: Burks et al. teaches the transaction element and the response transaction element contain transaction data pertaining to a predetermined automotive application (col. 6 line 63 – col. 7 line 24).

Claim 10. Burks et al. teaches the automotive information exchange system translates the response transaction element from the proprietary schema of the second trading partner to the universal schema and then to the proprietary schema of the first trading partner (col. 3 lines 2-25).

Claim 11: Burks et al. teaches:

- receiving a transaction element from a first automotive trading partner on to an automotive information exchange system, wherein the transaction element relates to an automotive application (col. 3 lines 2-25);

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- translating the transaction element from a proprietary schema of the first trading partner into a universal schema and from the universal schema into a proprietary schema of the second trading partner, wherein translation of the transaction element includes translating a data format and an application format of the transaction element (col. 3 lines 2-25);

- routing the transaction element to a second automotive trading partner (col. 3 lines 2-25);

sending a response transaction element from the second automotive trading partner to the automotive information exchange system (col. 3 lines 2-25); and

- routing the response transaction element to the first automotive trading partner (col. 6 line 63 – col. 7 line 24).

Claim 12: Burks et al. teaches:

- mapping the transaction element and the response transaction element with a mapping system, wherein the mapping comprises identifying the first trading partner, the second trading partner and an application to which the transaction element corresponds (col. 3 lines 2-25);

- managing the transaction element and the response transaction element with a transaction management system (col. 3 lines 2-25);

- wherein the managing step comprises tracking a status of the transaction element and the response transaction element (col. 4 lines 8-17); and



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- securing the automotive information exchange system with a security system  
(col. 9 lines 13-25).

Claim 13. (Canceled)

Claim 14. Burks et al. teaches translating the response transaction element from the second proprietary schema to the universal schema and then from the universal schema to the first proprietary schema (col. 6 line 67 – col. 7 line 24).

Claim 15. (Canceled)

Claim 21: Claim 21 is written as a program product and contains essentially the same limitations as claim 7; therefore, the same rejection is applied.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-2, 4-12, 14, 16-23, and 25-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argued the combination and compatibility of prior art used in Paper #7.

Applicants' amendment and argument necessitated revision of the rejection; therefore, examiner used the Burks et al. prior art to reject all claims.


Burks et al. teaches applicants' claimed invention, as particularly identified in the revised rejection above, and overcomes applicants' arguments. Therefore, examiner maintains the rejection of applicants' claimed invention.


### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FT   
06/09/2004

  
Jeffrey A. Smith  
Primary Examiner